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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,374	04/04/2001	Scott Jeffrey Sherr	041892-0207	2879

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EXAMINER	
BADII, BEHRANG	
ART UNIT	PAPER NUMBER
3694	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/826,374	SHERR ET AL.	
	Examiner	Art Unit	
	Behrang Badii	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *44-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *44-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Arguments

Applicant's arguments with respect to claims 44-61 have been considered but are moot in view of the new ground(s) of rejection.

Independent claim 44 has a repetition of a limitation. That is, a limitation of the independent claim 44 is repeated again in the same claim (claim 44). A clarification of this matter is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically it is unclear as to how a license can be verified if it is not generated or does not exist.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. It is unclear as to how a license can be verified before it is generated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 44-47 & 51, 53 & 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fucarile et al., U.S. patent 6,766,305, and further in view of Venkatesan et al., USPAP 2005/0039022.

As per claim 44 & 59-61, Fucarile et al. discloses a business method for controlling distribution of content to a network enabled device, the method comprising:

transferring selected content to the network enabled device, the selected content being supplied by a content owner (abstract);

communicating, over a network, a license associated with the selected content to the network enabled device, the license including access level information defining conditions for controlling the network enabled device to produce a user-perceptible form of the selected content when conditions defined by the access level information are met and to inhibit production of a user-perceptible form of the selected content when conditions defined by the access level information are not met (col.2, 54-67);

charging a license fee to a user of the network enabled device based on a license access level (col.2, 54-67); and

verifying based upon information independently derived from the network enabled device, that the license associated with the selected content is valid when access to the selected content is attempted (fig's 4, 6-10; col.3, 40-62; col10, 30-41; col.12, 18-41). Fucarile et al. does not disclose a license capable of being generated and downloaded at a different time than a time at which the selected content is transferred or the license being a separate file. Venkatesan discloses a license capable of being generated and downloaded at a different time than a time at which the selected content is transferred and the license being a separate file (p14 and 15). It would have been obvious to modify Fucarile to include a license capable of being generated and downloaded at a different time than a time at which the selected content is transferred and the license being a separate file in order to the software would contain the software implemented license as well as a suitable secret value ("secret"), the license would specify, in view of the license fee paid by the owner a degree of access (license grant) to which that owner is given to the object (p15).

As per claim 45, Fucarile et al. further discloses wherein charging the license fee to the user of the network enabled device comprises providing an interface for allowing the user of the network enabled device to select the license access level from a plurality of license access levels, each license access level defining a different set of conditions, wherein the license associated with the selected content includes access level information corresponding to the license access level selected by the user (col.2, 54-67).

As per claim 46, Fucarile et al. further discloses wherein the plurality of access levels comprise:

a level defining a time window in which the network enabled device may produce a user-perceptible form of the selected content no more than once; and

a level defining a time window in which the network enabled device may produce a user-perceptible form of the selected content an unlimited number of times (col.2, 54-67).

As per claim 47, Fucarile et al. further discloses paying to the content owner a percentage of the license fee charged for the license associated with the selected content (col.2, 25-43, 54-67; col.4, 17-21; col.5, 33-58).

Claims 48-50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fucarile et al., U.S. patent 6,766,305 as applied to claim 44 above, and further in view of Anderson et al., U.S. patent application publication 2004/0078490.

As per claims 48-50 and 52, Fucarile et al. discloses a business method as discussed above. Fucarile et al. does not disclose wherein demographic information associated with the license is used to compile a database of licensing information for various regions or wherein the database provides a plurality of parameters for available licenses for the content according to the determined geographical location of the user requesting the content or wherein the plurality of parameters comprises at least one of availability of the content at a particular time and availability of the content at a particular geographical location or wherein the geographical location of the user is determined from at least one of the user's credit card information, an IP address of the

user's computer system, and geographical information provided by the operating system of the user's computer system. Anderson et al. discloses wherein demographic information associated with the license is used to compile a database for various regions (abstract) or wherein the database provides a plurality of parameters for available content according to the determined geographical location of the user requesting the content (p.198, 208 & 367) or wherein the plurality of parameters comprises at least one of availability of the content at a particular time and availability of the content at a particular geographical location (p542) or wherein the geographical location of the user is determined from at least one of the user's credit card information, an IP address of the user's computer system, and geographical information provided by the operating system of the user's computer system (p45-46). It would have been obvious to modify Fucarile et al. to include wherein demographic information associated with the license is used to compile a database of licensing information for various regions or wherein the database provides a plurality of parameters for available licenses for the content according to the determined geographical location of the user requesting the content or wherein the plurality of parameters comprises at least one of availability of the content at a particular time and availability of the content at a particular geographical location or wherein the geographical location of the user is determined from at least one of the user's credit card information, an IP address of the user's computer system, and geographical information provided by the operating system of the user's computer system such as that taught by Anderson et al. in order to place licenses in the database according to

location and demographic such that any licensing done in the future can be carried out by research on the licenses already given according to location of the user.

As per claim 51, Fucarile et al. further discloses wherein the licensing information is provided to content owners (col.2, 25-43; fig's. 4 & 11).

As per claim 53, Fucarile et al. further discloses providing benefits to the user under defined circumstances (paying for each time used as opposed to paying a set fee, i.e. the user can pay less) (col.2, 54-67).

As per claim 54, Fucarile et al. further discloses wherein the benefits comprise charging a reduced license fee for the content (range of payments) (col.2, 54-67).

Claim 56 rejected under 35 U.S.C. 103(a) as being unpatentable over Fucarile et al., U.S. patent 6,766,305 as applied to claim 53 above, and further in view of Day et al., 2001/0013011.

As per claim 56, Fucarile et al. discloses a business method as discussed above. Fucarile et al. does not disclose wherein the defined circumstances comprise at least one of promotional gifts to the user, rewards to the user for referrals, rewards to the user for multiple downloads of the content, rewards to the user for non-download transfers of the content, and rewards to the user for purchasing a bundle of the content. Day et al. discloses wherein the defined circumstances comprise at least one of promotional gifts to the user, rewards to the user for referrals, rewards to the user for multiple downloads of the content, rewards to the user for non-download transfers of the content, and rewards to the user for purchasing a bundle of the content (p.6 & 36). It would have been obvious to modify Fucarile et al. to include wherein the defined

circumstances comprise at least one of promotional gifts to the user, rewards to the user for referrals, rewards to the user for multiple downloads of the content, rewards to the user for non-download transfers of the content, and rewards to the user for purchasing a bundle of the content such as that taught by Day et al. in order to entice and encourage users to strengthen the user base by coming back multiple times.

Claims 55, 57 & 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fucarile et al., U.S. patent 6,766,305 as applied to claims 53 and 44 above, and further in view of Runje et al., U.S. patent application publication 2001/0032312.

As per claims 55, 57 & 58, Fucarile et al. discloses the business method as discussed above. Fucarile et al. does not disclose wherein the benefits comprise coupons for purchase of merchandise or wherein charging a license fee comprises receiving payment information from the user of the network enabled device or wherein the payment information comprises the user's credit card information. Runje et al. discloses wherein the benefits comprise coupons for purchase of merchandise (p221) or wherein charging a license fee comprises receiving payment information from the user of the network enabled device (p221) or wherein the payment information comprises the user's credit card information (p221). It would have been obvious to modify Fucarile et al. to include wherein the benefits comprise coupons for purchase of merchandise or wherein charging a license fee comprises receiving payment information from the user of the network enabled device or wherein the payment information comprises the user's credit card information such as that taught by Runje et al. in order to enable the system to carryout the payments from the user by

identifying the users through their credit cards and therefore decreasing the rate of fraudulent activity throughout the payment system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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401 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(571) 272-3600**.

Behrang Badii
Patent Examiner
Art Unit 3694

BB

MARY D. CHEUNG
PRIMARY EXAMINER